



UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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08/720,070 09/27/96 HYATT

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ROBERT E BUSHNELL,
ATTORNEY-AT-LAW
1522 K STREET, N.W. SUITE 300
WASHINGTON DC 20005-1202

EXAMINER

JAYNE, D

ART UNIT

PAPER NUMBER

3627

40

DATE MAILED:

03/30/01

INTERVIEW SUMMARY

All participants (applicant, applicant's representative, PTO personnel):

- (1) Robert Bushnell (3)
(2) Darnell Jayne (4)

Date of Interview 3/6 & 3/7 & 3/29Type: Telephonic Televideo Conference Personal (copy is given to applicant applicant's representative).Exhibit shown or demonstration conducted: Yes No If yes, brief description: _____Agreement was reached. was not reached.

Claim(s) discussed: _____

Identification of prior art discussed: N/ADescription of the general nature of what was agreed to if an agreement was reached, or any other comments: See Attached.

(A fuller description, if necessary, and a copy of the amendments, if available, which the examiner agreed would render the claims allowable must be attached. Also, where no copy of the amendments which would render the claims allowable is available, a summary thereof must be attached.)

It is not necessary for applicant to provide a separate record of the substance of the interview.

Unless the paragraph above has been checked to indicate to the contrary. A FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION IS NOT WAIVED AND MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW.

Examiner Note: You must sign this form unless it is an attachment to another form.

Manual of Patent Examining Procedure, Section 713.04 Substance of Interview must Be Made of Record

Except as otherwise provided, a complete written statement as to the substance of any face-to-face or telephone interview with regard to an application must be made of record in the application, whether or not an agreement with the examiner was reached at the interview.

§1.133 Interviews

(b) In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111 and 1.135. (35 U.S.C. 132)

§ 1.2. Business to be transacted in writing. All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete a two-sheet carbon interleaf Interview Summary Form for each interview held after January 1, 1978 where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks in neat handwritten form using a ball point pen. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, pointing out typographical errors or unreadable script in Office actions or the like, or resulting in an examiner's amendment that fully sets forth the agreement are excluded from the interview recordation procedures below.

The Interview Summary Form shall be given an appropriate paper number, placed in the right hand portion of the file, and listed on the "Contents" list on the file wrapper. In a personal interview, the duplicate copy of the Form is removed and given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephonic interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication.

The Form provides for recordation of the following information:

- Application Number of the application
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (personal or telephonic)
- Name of participant(s) (applicant, attorney or agent, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the claims discussed
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). (Agreements as to allowability are tentative and do not restrict further action by the examiner to the contrary.)
- The signature of the examiner who conducted the interview
- Names of other Patent and Trademark Office personnel present.

The Form also contains a statement reminding the applicant of his responsibility to record the substance of the interview.

It is desirable that the examiner orally remind the applicant of his obligation to record the substance of the interview in each case unless both applicant and examiner agree that the examiner will record same. Where the examiner agrees to record the substance of the interview, or when it is adequately recorded on the Form or in an attachment to the Form, the examiner should check a box at the bottom of the Form informing the applicant that he need not supplement the Form by submitting a separate record of the substance of the interview.

It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview:

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner. The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he feels were or might be persuasive to the examiner,
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete or accurate, the examiner will give the applicant one month from the date of the notifying letter to complete the reply and thereby avoid abandonment of the application (37 CFR 1.135(c)).

Examiner to Check for Accuracy

Applicant's summary of what took place at the interview should be carefully checked to determine the accuracy of any argument or statement attributed to the examiner during the interview. If there is an inaccuracy and it bears directly on the question of patentability, it should be pointed out in the next Office letter. If the claims are allowable for other reasons of record, the examiner should send a letter setting forth his or her version of the statement attributed to him. If the record is complete and accurate, the examiner should place the indication "Interview record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

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Interview Summaries of March 6-7, 2001.

On March 6, applicant inquired as to the status of his request for interference with U.S. Patent 5,839,307 issued November 24, 1998. The examiner stated that an interference has not been declared since applicant does not have a claim which meets 37 CFR 1.607(b). Currently, there exists no interfering subject matter in the claims which would be patentable to the applicant subject to a judgment in an interference.

On March 6, applicant also inquired as to whether a notification under 37 CFR 1.607(d) was sent to the patentee. The notification to patentee has not been sent out because of a misunderstanding between applicant and the examiner. In several telephone interviews between the Office and the applicant's representative, it was the understanding of the Office that the applicant intended to file claims to the interfering subject matter in a separate application (see page 15 of Paper No. 27 filed October 6, 1999). Although applicant copied four claims from the Field et al. patent with his request for interference in Paper No. 26 on August 17, 1999, a notification was not sent out to patentee because of applicant's statement of intent to file the interfering subject matter in a divisional application (see page 15 of Paper No. 27 filed October 6, 1999) which included the cancellation of claims copied from the Field et al. patent. Such cancellation of the claims obviated the need to send notification to the patentee since it was the understanding of the Office that applicant sought to have patented an embodiment which did not contain interfering subject matter.

On March 6, applicant stated that he had renewed his request for interference subsequent to the cancellation of the interfering subject matter. The examiner asked for the Paper No.

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making such subsequent request. The applicant provided a copy of Paper No. 32 filed March 16, 2000 which provided four substantially verbatim copies of claims from the Field patent which were subsequently amended in Paper No. 33 filed April 25, 2000. The Examiner reviewed the material and, on March 7, informed applicant that a notification under 37 CFR 1.607(d) will be sent to the patentee on March 8, 2001.

It should be noted that upon subsequent review of Paper No. 32 filed March 16, 2000 the following remarks are necessary to make clear the official record and the status of the claims. Page 7 of Paper No. 32 contains a statement of inadvertent cancellation of some claims by previous amendment and that Paper No. 32 should be substituted for the papers dated 6 October and 17 November 1999. Such statement is completely against the rules for entering amendments as set forth in Paper 31 sent February 15, 2000 regarding Paper No. 29 filed November 30, 1999 which sought to un-amend the amendments of 6 October and 17 November 1999. Because such statement is not considered to be a proper amendment, claims 60-63 remain canceled by amendment in Paper No. 27, filed October 6, 1999. The status of all claims is set forth by the examiner in Paper No. 39 mailed November 13, 2000.

On March 7, the applicant requested a personal interview on March 14, 2001. The request for a personal interview has been denied by the Examiner. Applicant's representative has spoken on numerous occasions with the Examiner on the telephone. Also, a personal interview was granted on March 17, 2000. In a telephone interview on February 5, 1999, the examiner suggested claim language to place the application in condition for allowance (see Paper No. 20). The applicant's representative stated that he would make such changes in a supplemental amendment. Such changes were not made. In a personal interview on March 17, 2000 the examiner suggested claim language to the applicant and applicant's representative to place the

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application in condition for allowance. Applicant's representative agreed to make such changes (see Paper No. 32 1/2). Such changes were not made. The applicant's representative has made no showing that another interview would be productive to the Office or to the applicant.

**DARNELL JAYNE
PRIMARY EXAMINER**

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Interview Summary of March 29, 2001

The applicant requested a personal interview on March 14, 2001 to discuss the art rejections of Gokcebay in view of Thordmark, Gokcebay in view of Aston and Sengupta in view of Gokcebay. Applicant has made no showing that an interview would be productive and thus the request for a personal interview regarding the merits of the art rejections has been denied by the Examiner. The applicant stated that Office Action was incomplete for failing to particularly set forth what elements of the secondary references (e.g., Thordmark, Aston, and Gokcebay) were incorporated into the primary references (e.g., Gokcebay and Sengupta). The office action of November 13, 2000 goes into clear and exacting detail as to what embodiments and what structure the Examiner is relying on in her rejections. For example, applicant's attorney is invited to reread pages 7-9 of the office action and particularly, page 8, lines 7-16 which discusses Thordmark and the modified embodiment relied on by the Examiner and page 10, line 17 through page 11, line 3 of the office action which specifically discusses the embodiment shown in Figure 4 of Aston. Regarding Sengupta and the rejection of claims 65-67 and 69, the examiner has discovered a typo on page 13 line 1. The first word of line 1 should be Sengupta not Gokcebay. The examiner regrets this oversight.

The applicant inquired as to why the office action filed November 13, 2000 did not include a Director's signature required by MPEP 1003 Paragraph 6 which states "[a]ctions which hold unpatentable claims copied from a patent for interference purposes where the grounds relied upon are equally applicable to the patentee, MPEP 2307.02. The examiner stated that there existed no

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allowed claims copied from the Field et al. patent which would require the Director's signature. The applicant argued that the claims were substantially verbatim and that the grounds relied upon by the examiner are equally applicable to the patentee. The subject matter disclosed in U.S. Patent 5,839,307 is patentably distinct from any embodiment disclosed and claimed in the current application. Currently, there exists no allowable claim in this application which is identical to a claim in the Field patent or which would cover the embodiment disclosed in the Field et al. patent. Applicant's viewpoint that the grounds of rejection relied upon by the examiner for rejecting applicant's claims 85-89 are equally applicable to the patentee is not shared by the Examiner.

Darnell Jayne
DARNELL JAYNE
PRIMARY EXAMINER